

Page 43, lines 5-16 of applicant's specification discuss the pager based invention recited in claims 54 and 55. This section discusses:

Another method contemplated by the present invention of electronically transmitting coupon data uses conventional digital pager technology. As discussed in connection with Figure 5, coupon card 1 may also include a radio frequency receiver 15 which will be tuned to one or two frequencies. A transmitter station will transmit coupon information in a digital signal which will be received in a digital stream by receiver 15, read by microcompressor 25 and stored in RAM means 23 for future use by the coupon card user.

It is clear that the invention discloses transmitting coupon data using "conventional digital pager technology." The specification goes on to state that the "radio frequency receiver 15 will be tuned to one or two frequencies" and that "a transmitter station will transmit coupon information . . . which is received . . . by receiver 15." If the specification discloses the invention uses "conventional pager technology," the receiver is tuned to "one or two frequencies", and that the transmitter station transmits coupon information received by the radio receiver, the inescapable conclusion is that coupon data is being broadcast at pager frequencies. Applicant respectfully submits that it would be virtually impossible for a person of ordinary skill to reach any conclusion but that the specification teaches broadcasting coupon data at pager frequencies. Even if the exact words "pager frequency" are not recited, the use of such pager frequencies is the only possible interpretation of the specification.

Nor would a person of ordinary skill in the art have the slightest difficulty determining what radio frequencies are considered "pager frequencies." This is because those frequencies are strictly regulated by governmental authorities. Using the United States as an example the Federal Communications Commission (FCC) allocates certain

radio frequencies to pager systems. As an illustrative example, the attached page (Exhibit A) from the FCC's publicly available frequency allocation specifications indicate that pager frequencies include 901-902 MHz ("Narrowband PCS 2-way Paging") and 929-930 MHz ("Private Paging") among other strictly specified frequencies. There is no question that a person of ordinary skill in the art could readily determine what frequency ranges qualify as "pager frequencies."

Applicant further points out that MPEP §2164.04 places the burden of proof on the Examiner to show lack of enablement and that the Examiner must provide a reasonable explanation as to why the scope of the claim is not adequately enabled by the disclosure. Moreover, the Examiner's burden includes showing that a person of skill in the art would have to exercise undue experimentation before the invention may be considered nonenabling. As explained above, applicants specification very clearly describes how to make and use the invention by broadcasting coupon data at pager frequencies. The particular frequencies of the broadcast would be within the range allowed by the FCC. Absolutely no experimentation, much less undue experimentation, is required to make and use this invention. For all of these reasons, applicant submits that it is abundantly clear that a person of skill in the art could readily understand and readily make and/or use a method according to claim 54 wherein a "signal is broadcast at a pager frequency." The enablement rejection should be withdrawn.

II. Rejection of Claim 54-55 as obviousness over Ruppert and Begum.

Claim 54 recites broadcasting a signal carrying coupon data “wherein said signal is modified to be receivable by said specific storage device.” Citing Ruppert column 5, line 48 to column 6, line 18, the Examiner argued that:

Ruppert et al disclose a personal scanner/computer for displaying shopping lists and scanning barcodes to aid shoppers comprising: broadcasting a predetermined coupon data (sale items) to a specific device (every device is specific having their specific serial number or code to be identified by the system), wherein the signal data is modified (the signal is modify to include list price data and coupon data for sale items) to be received by said specific storage device (see col. 5, line 48 to col. 6, line 18).

However, the cited portions of Ruppert do not disclose what the Examiner claims. While the Examiner is entitled to give the claims their broadest reasonable interpretation, the Examiner is not allowed to effectively read limitations out of the claims. Ruppert discloses “specific devices” only in the sense that Ruppert contemplates that there will be multiple handheld scanners in his system. There is no indication that each device is somehow separately identifiable within the Ruppert system. The cited section of Ruppert simply discusses how bar codes are scanned by the hand held scanners, how a running total of items in the shopping basket is maintained, and how a store price list is entered into the handheld scanners. None of these functions require the Ruppert system to *individually identify* different scanners and there is absolutely no indication that the Ruppert system does in fact individually identify different scanners based upon “specific serial number or code” as claimed by the Examiner. Applicant respectfully requests that the Examiner identify where in column 5, line 48 to column 6, line 18 of Ruppert this disclosure may be found.

Additionally, there is no indication that the Ruppert signal is modified to be *receivable* by a specific storage device. The Examiner argues that because the Ruppert

signal is modified to include price data and coupon data for sale items, that this action is modifying the signal to be receivable by a specific device. However, the second assertion in no way logically follows the first. Including price data and coupon data for sale items in no way modifies the signal to be received by one particular Ruppert handheld scanner as opposed to another. The price data and coupon data is simply the information being conveyed by the signal and does absolutely nothing to influence which particular hand held scanner receives the signal. Ruppert intends that each hand held scanner receive exactly the same price data and coupon data, and therefore, the signal generated by the Ruppert system is being broadcast in the store-wide and any device carried into the store presumably receives the signal. Ruppert intends the same signal to be received by all the handheld scanners in Ruppert's system. This is the opposite of applicant's claimed method were a signal is modified to be receivable by a specific storage device.

No person of ordinary skill in the art would read Ruppert and reach the conclusion that Ruppert is somehow modifying a signal to be receivable by a specific storage device. Applicant respectfully submits that it only after reading applicant's disclosure and utilizing hindsight that anyone would attempt to stretch Ruppert's disclosure to include modifying a signal to be receivable by a specific storage device. Clearly the use of such hindsight is contrary to Patent Office examining procedure.

The Examiner also rejected claim 55 arguing that "the specific frequency at which the system broadcasts falls within the engineering design choice for meeting a specific requirement." The Examiner further stated, "It would have been obvious for an artisan to modify the system of Ruppert et al as modified by Begum et al to broadcast at various frequencies to reach different types of users."

First, applicant notes that it is clear that Ruppert only intends to broadcast within the store and that is why Ruppert uses IR signals as opposed to radio signals. This is also why the Examiner had to rely on Begum's disclosure of radio transmissions to reject claims 54 and 55. However, Begum is attempting to accomplish the same thing as Ruppert, i.e. the transmission of local signal within a store. Looking at the section of Begum cited by the Examiner and the immediately following text (col. 4, line 63 to col. 5, line 5), this becomes abundantly clear. Here Begum discusses communication unit 14 is prompted at a checkout counter 41 and how the coupon exception file is transmitted to a receiver at *the checkout counter*. Thus, Begum is attempting to transmit very short distances. This is one important reason Begum would not teach transmitting and receiving at pager frequencies. Operating at pager frequencies would practically guarantee large scale interference by powerful pager broadcasts originating outside the store. If the Begum receiver was designed to receive signals at pager frequencies, it would be inundated with outside pager signal noise and could not operate as intended. Thus, the modification of Begum and Ruppert suggested by the Examiner would destroy the intended function of these references. Under such circumstances, the combination of the two references is clearly improper.

Additionally, the Examiner simply assumes, without any explanation, that a person of ordinary skill would be allowed by the FCC to modify the Ruppert (or Begum) system to transmit at pager frequencies. However, it is more logical to presume that the FCC would in fact not allow one using the Ruppert or Begum systems to generate pager frequency signals not intended for pagers. This is one more reason that a person of ordinary skill would never consider employing pager frequency signals in the Ruppert or


Begum system. Therefore, the rejection of claim 55 is plainly in error and should be withdrawn.

For all the above reasons, applicant respectfully submits the present rejections should be withdrawn and the claims allowed. Additionally, applicant requests the Examiner consider the lengthy prosecution history of this application should the Examiner be inclined to maintain the rejections. It appears from the record that on two separate occasions when applicant was appealing final rejections, the Examiner issued new office actions rather than defend the rejections on appeal. Applicant believes the present final rejection is no stronger than the previous final rejections which the Examiner chose not to defend on appeal. Applicant asks the Examiner to keep in mind that this unusually drawn-out prosecution places a huge financial burden on the applicant. If the Examiner maintains the rejection of these claims, applicant requests the opportunity to conduct a telephone conference with the Examiner and his supervisor.

Respectfully Submitted:

Date:

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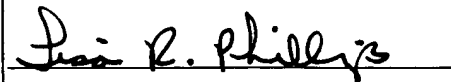


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Lisa R. Phillips

Non-Government										Government	
Allocation (MHz)	"Common" Service Name	Bureau and Rule Part	Terrestrial Services			Satellite Services			Allocation (MHz)	Util.	
			Operational Parameters	Usage	Utilization	License Type	Orbit	Utilization / Coverage			
896 – 901 FIXED LAND MOBILE US116 US268	Private Land Mobile	WTB pt 90	V/D 2-way 13.6 kHz channels analog/digital	P-R S MTA C	plm: 46,655				896 – 901		
901 – 902 FIXED MOBILE US116 US268	Narrowband PCS 2-way Paging MO	WTB pt 24	V/D/I; 1 & 2- way	USA Regional MTA BTA					US116 US268 G2 901 – 902		
902 – 928 US116 US268	Location & Monitoring Service	WTB pt 90	D; 2-way; BW based on need	S MTA; C	plm: 58,022				US116 US268 G2 902 – 928 RADIOLOCATION	490	
150 US215 US218 US267 US275	Amateur Radio unlicensed	WTB pt 97 OET pt 15	V/D/image 2- way 2 or 12 MHz channels analog/digital	USA OmniDir					150 US215 US218 US267 US275 G11 G59		
928 – 929 FIXED US116 US215 US268 NG120	MAS CONTROL	WTB pt 22 & 101	Data; 1 or 2- way transmission; 12.5 & 25 kHz channels; Analog/digital	P-R S & P-R	plm: 7,568 clm: 358				928 – 929 US116 US215 US268 G2 929 – 930		
929 – 930 FIXED LAND MOBILE US116 US215 US268 NG120	Private Paging	WTB pt 90	V/D 1-way 20 kHz channels analog/digital	P-R P-MP	plm: 81,269				US116 US215 US268 G2 930 – 931		
930 – 931 FIXED MOBILE US116 US215 US268 NG120	Narrowband PCS	WTB pt 24	V/D/I; 1 & 2- way	USA Regional MTA BTA	0				US116 US215 US268 G2 931 – 932		
931 – 932 FIXED LAND MOBILE US116 US215 US268 NG120	CMRS; CCP	WTB pt 22	V/D; 40, 20 kHz channels	S; C; P-R; (MTA proposed)	clm: 31,959				US116 US215 US268 G2 931 – 932		
US116 US215 US268 NG120									US116 US215 US268 G2		

EXHIBIT

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